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Diane L. Marschang
GENENTECH, INC.
1 DNA Way
South San Francisco, CA 94030

In re Application of
KELLEY, et al.
U.S. Application No.: 10/519,647
PCT No.: PCT/US03/19750
Int. Filing Date: 23 June 2003
Priority Date: 24 June 2002
Attorney Docket No.: P1966R1
For: APO-2 LIGAND/TRAIL VARIANTS AND
USES THEREOF

DECISION ON PETITION

UNDER 37 CFR 1.47(a)

This decision is in response to applicant's "Petition To Accept Application Under 37 CFR 1.47(a)" filed 10 January 2006 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 29 June 2003, applicant filed international application PCT/US03/19750, which claimed a priority date of 24 June 2002. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 24 December 2004.

On 22 December 2004, applicant filed a transmittal letter for entry into the national stage in the United States accompanied by the requisite basic national fee and an Information Disclosure Statement.

On 03 August 2005, applicant was mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" (Form PCT/DO/EO/905) informing applicant of the need to provide an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. Applicant was afforded two months to file the proper reply and informed that this period could be extended pursuant to 37 CFR 1.136(a).

On 10 January 2006, applicant filed the present petition under 37 CFR 1.47(a) accompanied by a petition for a five-month extension of time and payment of the appropriate five-month extension fee. With the filing of the extension of time petition and payment of the extension fee, applicant's response is considered timely filed.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint investor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Applicant has satisfied all four items.

Regarding item (1), applicant has provided payment of \$130.00. Applicant is advised that the petition fee for a petition under 37 CFR 1.47 is \$200.00 pursuant to 37 CFR 1.17(g). As authorized, \$70.00 will be charged to deposit account number 07-0630.

As to item (2), the Manual of Patent Examining Procedure (MPEP) at section 409.03(d) explains that in a situation where the non-signing inventor cannot be located:

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

Applicant has provided sufficient evidence to show that Ms. Lindstrom could not be located. Specifically, applicant has included a signed declaration of Ms. Mona Beltran detailing her efforts to locate Ms. Lindstrom, including searching the internet. In addition, applicant has included a copy of the internet search results.

Regarding item (3), applicant has provided the last known address of the non-signing inventor.

As to item (4), applicant has filed a compliant declaration of the inventors executed by the remaining inventors on their own behalf and on behalf of the non-signing inventor.

Accordingly, it is proper to grant applicant's petition at this time.

CONCLUSION

For the reasons above, applicant's petition under 37 CFR 1.47(a) is **GRANTED**.

The application has an international filing date of 23 June 2003 under 35 U.S.C. 363, and will be given a date of **10 January 2006** under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

As provided in 37 CFR 1.47(c), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record. A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

This application is being returned to the DO/EO/US for processing in accordance with this decision. Specifically, the mailing of a Notification of Acceptance (Form PCT/DO/EO/903).



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Dear Ms. Lindstrom:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor. As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternately, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join in the application, the law firm of record (see below) would presumably assist you. Joining in the application would entail the filing of the appropriate oath or declaration by you pursuant to 37 CFR 1.63.

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